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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/754,031 | 01/02/2001 | William J. Payer | | 2037 |

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WILLIAM J PAYER
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EXAMINER

NGUYEN, CHI Q

| ART UNIT | PAPER NUMBER |
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3635

DATE MAILED: 12/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/754,031

Applicant(s)

PAYER, WILLIAM J.

Examiner

Chi Q. Nguyen

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/1/03 has been entered.

Specification

The abstract of the disclosure is objected to because the letters should be in lower case formed. Correction is required. See MPEP § 608.01(b).

Claim Objections

Claim 2 is objected to because of the following informalities: the applicant is advised to remove the doubled spaces in lines 2, 7. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-28 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a

manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

Specifically, claim 1 the applicant's claimed language is confusing such as the claim preamble cited as "The method..." is considered indefinite and lack of antecedent of basis in the claim; the applicant uses a term "typically" in every line of the claim; It is unclear the actual claimed language that the applicant tried to cite because the claimed recitation is lengthy and no punctuations. A phrase "the said" renders the claim indefinite and confusing. Since the claims must be in one sentence form only, then the applicant is advised to remove "." on each ended paragraph of the same claim. The other claims 2-28 having the similar issues as claim 1.

Claims 3, and 6-28 are indefinite because the independent claim 1 appears as method claim; however, dependent claims 3, 6-28 are depending on claim 1 and no actual method steps are claimed.

Claims 4 and 5 provides for the use of "typically horizontally placed beams and girders with said girders webs partially separated with said beams extending through boundaries of said partially separated webs of said girders", but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 4 and 5 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper

definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

As best understood, claims 2, 4, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood (US 3,304,675) in view of Simenoff (US 5,123,220).

In regard to claims 2, 4, and 5, Wood teaches a building structure comprising a plurality of vertical or column steel members 11, a plurality of horizontal or floor steel members 12, which defined a boundary and bolted to a foundation 10; each column 11 having rectangular frame formed of channel sectioned steel side members 13 and end members 14 and each floor beam 12 is of metal, being z-shaped in cross section having flange 17, web 19, girders 41 having upper chord, lower chord, webs in between (see fig. 4). Wood does not teach expressly the horizontal beams having perforated shapes. Simenoff teaches column assembly having a plurality of vertical beams 12, a plurality of horizontal beams 24 having a plurality of perforated shaped (fig. 2). At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine Wood and Simenoff for the beams having plurality of perforated shapes. The motivation

for doing so would have been to provide the cementitious material anchoring through the beams thus enhances the stronger bonding for the building structures.

As best understood, claims 1, 3, 6-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood (US 3,304,675) in view of Simenoff (US 5,123,220) and further in view of Bowers (US 3,605,350) and Ford (US 5,638,651).

Wood, Simenoff teach the structural elements for the building structures as stated except for the structural members are jointed by welds and coating with rust-inhibitive material.

Bowers teaches a building construction comprising a plurality of vertical members 18, a plurality of horizontal members 12, 14 forming typically rectangular configuration and defined a boundary with a foundation 32. The vertical members 18 are tubular steel posts and are welded to the side beams 12, 14 (see col. 3, lines 58-70). And Ford further teaches interlocking panels building system which including galvanized steel channels 148 within the panels 146. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Wood, Simenoff with Bowers and Ford for the building structures jointed together by welds and coating steel members by galvanized coating. The motivation for doing so would have been to provide more securement and preventing corrosion.

With regard to the method claims 1, 3, 6-28, Wood, Simenoff, Bowers, and Ford teach the structural elements for the building members as stated except for the method of assembly, examiner considers this to be the obvious method of setting up device because in forming a building, one must obviously form a foundation, erect steel post

member over the foundation, joint horizontal beams with the vertical post by welds, secure the girders over the horizontal beams, coating the steel members by galvanized.

Response to Arguments

Applicant's arguments with respect to claims 1-28 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Chi Q. Nguyen whose telephone number is (703) 605-1224, Mon-Thu (7:00-5:30), Fridays off or examiner's supervisor, Carl Friedman can be reached at (703) 308-0839. The fax number for the organization where this application or proceeding assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



CQN
11/18/03



Carl D. Friedman
Supervisory Patent Examiner
Group 3600